

Express Mail No. EV554439641US
Docket No. 1062.013 (61632)

REMARKS

In the Office Action mailed March 25, 2005, the Examiner rejected claims 1, 3-18, 20 and 21. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 1, 6, 11 and 14. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

For the present application, Applicants have made several arguments as to the patentability of the claims of the present application. For expediency, each of those arguments is incorporated herein by reference and applicants confine the scope of arguments in the current response to 1) language suggesting greater than about 300% elongation for an adhesive and 2) language suggesting assembly of the roof module to B and C pillars of an automotive vehicle. As can be seen above, the aforementioned language (either 1 or 2 or both) was already in certain claims (i.e., claims 9 and 17) prior to the above amendments and has been added to certain claims (i.e., claims 1, 6 and 14) by the above amendments. Additionally, claim 11 has been amended to include additional language and Applicants contend that claim 11 is patentable over the references of record since none of the references disclose the subject matter of that claim.

Rejections under 35 USC 103

The Office Action rejected each of the claims of the present application under 35 USC 103 as being obvious in view of combinations of two or more of the following references: Hill et al. (US patent 6,493,920); Miyazaki et al. (US patent 4,883,310); Wandiez (US patent 6,409,947); Johnston (US patent 4, 712, 287); (Derwent '380); Lumpe et al. (US patent 6,592,176); Hsieh (US patent 5,115,086) and Bhat et al. (US patent 6,133,398). Applicants have amended certain of the claims to expedite prosecution and believe that those claims are patentable over the references of record. Applicants specifically traverse the rejections of claims 9 and 17.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim again the prior art." *In re Wilson*, 424 F2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In the case of *In re Lee*, the Court of Appeals for the Federal Circuit (the CAFC) wrote:

The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

300% Elongation

The Office Action in rejecting claim 17 and its dependents suggests at page 14 that, "it is known to use adhesives having an elongation ... greater than 300 percent in bonding an automobile windshield to the windshield frame as attested by Bhat et al." The Office Action further suggests that, "it would have been obvious...to have used an adhesive having an elongation that is greater than about 300 percent...in order to shorten production time."

Applicants traverse this rejection for failure to establish a *prima facie* case of obviousness. In particular, Applicants contend that the motivation provided by the Office Action is not sufficiently specific for maintaining the asserted obviousness rejection. In particular, the Office Action does not show how the prior art provides any specific motivation for providing an adhesive with elongation greater than about 300% for forming an adhesive connection between a bottom edge of a transparent panel (e.g., a windshield) and a body of vehicle wherein the transparent panel is already part of a roof module at the time of the adhesive connection. At best, the concept of "shortening production time" might suggest reasoning as to why an individual would use an adhesive with a shorter curing time in very general terms. However this concept does not suggest why an individual would be motivated to use an adhesive having elongation of 300% as employed with the roof module of the claims of the present application.

Applicants inventive use of such an adhesive for the roof module of the present application can provide advantage during assembly of the roof module to the body of the vehicle. In particular, the 300% elongation can accommodate greater tolerances between the roof module, particularly the transparent panel (e.g., windshield), and the body of the vehicle during attachment, after attachment or both. Generally, tolerances for assembly of a roof module can be relatively large due to factors such as i) separate manufacture of the roof module from the body and ii) the fact that a large, relatively hard to maneuver, roof module assembly is being positioned upon the body during assembly. Thus, the accommodation of the tolerances, by the adhesive, particularly for the roof module claimed in the present application, can be a reasonably significant advantage.

Assembly of the roof module to B and C pillars of an automotive vehicle

The Office Action suggests at page 15 that, "Lumpe et al. supports the examiner's statement that 'it is within the general knowledge of one of ordinary skill in the art to provide appropriate roof panels to vehicle models having B and C-pillars'". Applicants contend that neither the Office Action nor this statement establish a *prima facie* case of obviousness against claims 9 and 17 and their dependents, particularly claim 18. Moreover, the use Lumpe et al. as a reference for teaching attachment of a roof module to B and C-pillars is improper since the rejection based upon Lumpe et al. and the other references fails to establish obviousness of the subject matter of at least claims 9, 17 and 18 as a whole.

As a whole, claims 9, 17 and 18 involve a method that includes the attachment of a roof module having a transparent to B and C-pillars of an automotive vehicle. Moreover, in at least claims 9 and 18, that panel is a windshield disposed between A-pillars of a vehicle. In contrast, the "roof module" of Lumpe et al. does not include any pillars, nor does it include a transparent panel or a windshield. As discussed above, neither Lumpe et al. nor the other references of record suggest the methodology of claims 9, 17 and 18. However, in addition, the use of Lumpe et al. as a reference against at least claims 9, 17 and 18 ignores multiple potential advantages of subject matter of claims 9, 17 and 18 as a whole. As one of multiple potential advantages to the methodology of claims 9 and 18, attachment of the roof module including the transparent panel or windshield to the B and C pillars can be allow for easier assembly to the body because the roof module can be brought in and assembled to the vehicle body at least partially and more easily from the front of the body as the body is moved forward in an assembly line. Such assembly can make it unnecessary to stop the forward motion of the body on the assembly line during assembly of the roof module to the body, although such is not required for the present invention. As another advantage, attachment of the roof module to the B and C pillars of the body can assist in aligning the A-pillars and/or the transparent panel (e.g. windshield) properly with the body for proper attachment (e.g., proper adhesion) of the transparent panel (e.g., windshield) and/or A-pillars to the body. This can minimize what might otherwise require larger attachment tolerances.

Moreover, Applicant points out that it would likely be improper to present a final rejection of claims 9, 17 and 18 on a grounds alternative to that already presented since applicants have not amended claims 9, 17 and 18 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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